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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,453	08/26/2003	Bruce Foster	27087/39162	5076
4743 7590 10/16/2007 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER HARPER, TRAMAR YONG	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 10/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/648,453

Applicant(s)

FOSTER, BRUCE

Examiner

Tramar Harper

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-12 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-12, & 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Examiner acknowledges receipt of Request for Continued Examination filed 8/9/07. Examiner acknowledges receipt of amendment/arguments filed 6/26/07. Claims 1, 3, 5-12, & 14-22 are pending, Claims 1, 5, 6, 12, 14, & 20-21 are currently amended, and Claims 2, 4, & 13 have been canceled.

Claim Objections

Claim 6 is objected to because of the following informalities: Examiner contends that claim 6 is meant to depend off claim 1 and not canceled claim 4. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5-12, & 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chi (US 2002/0111203).

Claims 1, 12, 10, & 19: Chi discloses a base having a receiving area, wherein a plurality of removable puzzle pieces placed within the receiving/key unit area and cooperating or joined to form an assembled image. The base comprises of a sound generator connected to a power source. The receiving area comprises of a first and second substrate made of a conductive film (same material). The first substrate has a

Art Unit: 3714

conductive longitudinal pattern and the second substrate has a conductive transverse pattern. The lines/patterns within the substrates are formed of silver gel and carbon power, which is known as a form of conductive ink. Both substrates overlap each other to form a conductive dot matrix and below the actual receiving area where the puzzle pieces are placed (§§ 20-22). The substrates are coupled to the control unit (sound generator). Both substrates are relatively displaceable to thereby permit contact between the conductive substrates upon pressing the selected portion of the image via the removable puzzle pieces such the substrates cooperate to form an electrical circuit thereby activating the sound generator (§§ 28-29).

Chi fails to disclose the first and second substrates formed from the same piece of a single paperboard blank material. Chi discloses that the substrates are both made of a conductive film (see above). However, applicant fails to disclose that having the first and second substrates formed from the same piece of a single paperboard blank material or the substrates formed of paperboard blank material in general solves any stated problem or is for any particular purpose. Furthermore, Applicant discloses that is preferable (which is interpreted as not mandatory or required) for substrates to be formed of the same paperboard blank (§§ 5). Moreover, it appears that the substrates of Chi, or applicant's invention, would perform the same function of providing an electrical contact means for actuating sound when a puzzle piece is placed in a selected portion of the receiving area, regardless of the type of substrate material. Therefore, it would have been prima facie obvious to modify Chi to obtain the invention as specified in

claims 1 & 12 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Chi.

Claims 3, 5, & 14: Chi further discloses a third substrate or isolating film that separates the first and second substrates from each other. The third substrate contains a plurality of through hole or apertures corresponding to the contacts or conductive patterns forming the dot matrix on the first and second circuit contained films or substrates (§ 20-23).

Claims 6 & 15: Chi does not explicitly teach of a the substrates being die cut, Chi does teach of cutout pieces such as puzzle pieces and electronic board pieces. It is obvious to one skilled in the art that a cutout piece must have had to be cut.

Claims 7 & 16: Chi fails to disclose the substrates being separated by fold lines. Chi discloses the first, second, and third substrates as individual parts (Fig. 1). However, applicant fails to disclose that having the substrates separated by fold lines solves any stated problem or is for any particular purpose. Furthermore, Applicant discloses that alternatively the substrates may be formed of individual and separate panels (§ 22), which makes either means equivalent. Moreover, it appears that the individual substrates of Chi, or applicant's invention, would perform the same function of providing an electrical contact means for actuating sound when a puzzle piece is placed in the receiving area, regardless of whether the substrates are individual parts or one panel separated by fold lines. Therefore, it would have been prima facie obvious to modify Chi to obtain the invention as specified in claims 7 & 16 because such a modification

would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Chi.

Claims 8 & 17: Chi does not explicitly teach of applying the conductive ink of the substrates in one printing operation, it is obvious for one skilled in the art to only use one printing operation to perform a printing action. This reduces costs since multiple printing operations cost more production cost and occupy more time to produce the product. Thus, it would be obvious for one skilled in the art to use only one printing operation to print the conductive ink on the substrates.

Claims 9 & 18: Chi discloses that the first substrate contains at least a first and second portion (conductive lines), wherein when a particular puzzle piece corresponding to the first and second portion is pressed onto the first substrate area the first substrate come into contact with the second substrate forming a conductive dot matrix. The respective lines are thus connected through the contact with the second substrate (Figs. 1-6 & above).

Claim 11: Chi discloses tabs on the first and second substrates that for placing in a slot of the base of the puzzle device (Fig. 1).

Claims 20-22: Chi discloses a base having a receiving area, wherein a plurality of removable puzzle pieces placed within the receiving/key unit area and cooperating or joined to form an assembled image. The base comprises of a sound generator connected to a power source. The receiving area comprises of a first and second substrate made of a conductive film (same material). The first substrate has a conductive longitudinal pattern and the second substrate has a conductive transverse

pattern. The lines/patterns within the substrates of formed of silver gel and carbon power, which is known as a form of conductive ink. Both substrates overlap each other to form a conductive dot matrix and below the actual receiving area where the puzzle pieces are placed (§ 20-22). The substrates are coupled to the control unit (sound generator). Both substrates are relatively displaceable to thereby permit contact between the conductive substrates upon pressing the selected portion of the image via the removable puzzle pieces such the substrates cooperate to form an electrical circuit thereby activating the sound generator (§ 28-29). Furthermore, Chi further discloses a third substrate or isolating film that separates the first and second substrates from each other. The third substrate contains a plurality of through hole or apertures corresponding to the contacts or conductive patterns forming the dot matrix on the first and second circuit contained films or substrates, the third substrates keeps the contact points of the first and second substrate aligned and in spaced relation (§ 20-23).

Chi fails to disclose all the substrates formed from the same piece of a single paperboard blank material and having the same thickness. Chi discloses that the substrates are both made of a film, which implies the same type of film and thickness (see above). However, applicant fails to disclose that having all the substrates formed from the same piece of a single paperboard blank material (which encompasses same thickness) or the substrates formed of paperboard blank material in general solves any stated problem or is for any particular purpose. Furthermore, Applicant discloses that is preferable (which is interpreted as not mandatory or required) for substrates to be formed of the same paperboard blank (§ 5). Moreover, it appears that the substrates of

Chi, or applicant's invention, would perform the same function of providing an electrical contact means for actuating sound when a puzzle piece is placed in a selected portion of the receiving area, regardless of the type of substrate material. Therefore, it would have been prima facie obvious to modify Chi to obtain the invention as specified in claims 20 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Chi.

Chi fails to disclose the substrates being separated by fold lines. Chi discloses the first, second, and third substrates as individual parts (Fig. 1). However, applicant fails to disclose that having the substrates separated by fold lines solves any stated problem or is for any particular purpose. Furthermore, Applicant discloses that alternatively the substrates may be formed of individual and separate panels (§ 22), which makes either means equivalent. Moreover, it appears that the individual substrates of Chi, or applicant's invention, would perform the same function of providing an electrical contact means for actuating sound when a puzzle piece is placed in the receiving area, regardless of whether the substrates are individual parts or one panel separated by fold lines. Therefore, it would have been prima facie obvious to modify Chi to obtain the invention as specified in claim 12 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Chi.

Response to Arguments

Applicant's arguments with respect to claims 1, 3, 5-12, & 14-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Milner (US 4,796,891), Kuo (US 5,205,557), and Baxter (GB 2 337 942 A) all teach a similarly structured puzzle game with sound generator.

Mazurk (US 4,317,011) teaches a membrane touch switch with a first, second, and third substrate and conductive patterns and dots.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tramar Harper whose telephone number is (571) 272-6177. The examiner can normally be reached on 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ronald Laneau
Primary Patent Examiner
Art Unit 3714

TH

10/11/07